



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,180	02/25/2002	Bruce L. Davis	P0585	1232

23735 7590 03/30/2007
DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
----------	--------------

2155

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/086,180	DAVIS, BRUCE L.	
	Examiner	Art Unit	
	David Lazaro	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 27, 28 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 27, 28 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 01/09/2007.
2. Claims 1-15, 27, 28 and 33 are pending in this office action.

Response to Amendment

3. Applicant's arguments filed 01/09/2007 have been fully considered but they are not persuasive. See Response to Arguments. As such, the grounds of rejection presented in the 10/18/2006 office action, are respectfully maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 10, 11, 27 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,760,916 by Dellert et al. (Dellert).

6. With respect to Claims 1, 10 and 33, Dellert teaches a method of printing a trusted image, comprising:

an individual user electronically contacting an agency, soliciting an image depicting the user stored in an archive maintained by said agency (Col. 8 line 53 - Col. 9 line 6, Col. 9 lines 25-34 and Col. 1 lines 4-9: user electronically contacts hub station,

Art Unit: 2155

which archives the users images, to request an image or images. The scope of photography and user's photographs would include images depicting the user).

electronically receiving said image from said contacted agency (Col. 9 lines 23-34);

printing a document incorporating said image (Col. 9 lines 23-49).

Dellert does not explicitly state the agency maintaining the archive is a governmental agency. However, as noted by applicant (Page 7 of the remarks), one skilled in the art would recognize that an image archive is the same regardless of the entity maintaining the image archive. As such, an agency maintaining the image archive as taught by Dellert would be the same as a governmental agency maintaining an image archive.

Based on this, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have an individual user electronically contacting a governmental agency, soliciting an image depicting the user stored in an archive maintained by said governmental agency and electronically receiving said image from said contacted governmental agency. It is desirable to allow users to remotely access images regardless of the type of agency storing those images (Col. 2 lines 11-27). The type of agency/entity is descriptive and does not form a patentable distinction.

7. With respect to Claim 2, Dellert further teaches it is the individual user who receives said image and prints said document (Col. 9 lines 23-34).

8. With respect to Claim 3, Dellert further teaches said document is a photo identification document (Col. 3 lines 23-49).

Art Unit: 2155

9. With respect to Claim 5, Dellert does not explicitly disclose the governmental agency is a motor vehicle licensing agency, and the image is a driver license photo.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The soliciting, receiving and printing would be performed the same regardless of the agency being a motor vehicle licensing agency and the image being a driver license photo. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the governmental agency be a motor vehicle licensing agency, and the image being a driver license photo because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

10. With respect to Claim 11, Dellert teaches a method of distributing a trusted image, comprising:

at an agency, receiving an electronic request for an archived personal image from an individual depicted in said image (Col. 8 line 53 - Col. 9 line 6, Col. 9 lines 25-34 and Col. 1 lines 4-9: hub station, which archives the users personal images, electronically receives user request for an image to request an image or images. The scope of photography and user's photographs would include images depicting the user); electronically transmitting said image to said individual (Col. 9 lines 23-34).

Art Unit: 2155

11. With respect to Claim 27, Dellert teaches printing said document at a home of said individual user (Col. 9 lines 23-34).

12. Claims 4, 6-9, 12-15 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dellert in view of U.S. 5,841,886 by Rhoads (Rhoads).

13. With respect to Claim 4, Dellert does not explicitly disclose said document is an identification badge.

Rhoads teaches identification documents can include identification badges (Col. 1 lines 27-34 and Col. 6 lines 44-57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said document is an identification badge. One would be motivated to have this as identification badges are desirable and widely used for identification purposes (In Rhoads: Col. 1 lines 27-34 and Col. 6 lines 44-57).

14. With respect to Claim 6, Dellert does not explicitly disclose said image is processed with an identification code by the governmental agency.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is processed with an identification code. One would be

Art Unit: 2155

motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

15. With respect to Claim 7, Dellert teaches all the limitations of Claim 1, but does not explicitly disclose said image is digitally watermarked with a plural-bit code by the governmental agency.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code by the governmental agency. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

16. With respect to Claim 8, Dellert further teaches said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

17. With respect to Claim 9, Dellert further teaches said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

18. With respect to Claim 12, Dellert teaches all the limitations of Claim 11, but does not explicitly disclose processing said image with an identification code prior to said electronic transmission.

Rhoads teaches an image can be processed with an identification code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is processed with an identification code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

19. With respect to Claim 13, Dellert teaches all the limitations of Claim 11, but does not explicitly disclose digitally watermarking said image with a plural-bit code prior to said electronic transmission.

Rhoads teaches an image can be digitally watermarked with a plural-bit code (Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that said image is digitally watermarked with a plural-bit code prior to electronic transmission. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

20. With respect to Claim 14, Dellert further teaches said plural bit code serves to identify the individual user's name (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

21. With respect to Claim 15, Dellert further teaches said plural-bit code comprises an index into a data structure in which the individual user's name is stored (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

Art Unit: 2155

22. With respect to Claim 28, Dellert does not explicitly disclose obtaining from a database maintained by said governmental agency a name of said individual user, and printing said obtained name on the document.

Rhoads teaches obtaining from a database a name of said individual user and printing said obtained name on the document (In Rhoads Col. 1 lines 46-67 and Col. 7 lines 30-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Dellert and modify it as indicated by Rhoads such that it further comprises obtaining from a database maintained by said governmental agency a name of said individual user, and printing said obtained name on the document. One would be motivated to have this, as it enhances the security of photo identification documents (In Rhoads: Col. 7 lines 4-11).

Response to Arguments

23. Applicant's arguments filed 01/09/2007 have been fully considered but they are not persuasive.

24. Applicant argues on page 2 of the remarks - "*The Office stretches too far in arguing that Kodak and the government are both agencies, thereby rendering one to be obvious over the other.*"

- a. Examiner's response - The examiner asserts that a broadest reasonable interpretation has been made that is consistent with the specification. The examiner interprets the claimed agency as being an organization or company providing a service to another, particularly a service providing an electronic

image upon user request as seen in the specification and claims. As such, clearly the Kodak organization disclosed in Dellert can be considered an "agency". Applicant's own description of Kodak states that Kodak is a service provider, providing services to consumers, the services related to electronic access to images (See page 2 of the 01/09/2007 remarks).

b. In relation to applicants remarks concerning enablement (Page 7 of the 05/02/2006 remarks), the examiner is not asserting that those remarks alone establish obviousness. The examiner asserts that those remarks provide evidence of obviousness when considered in combination with the teachings of Dellert. In relation to the time of the invention, note the following:

"A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." (MPEP 2165.01(a))

As such, applicant's statement, "However, an artisan would recognize that an image archive (e.g., database) is the same, whether it is maintained by a state DMV, or by Google." (Page 7 of 05/02/2006 remarks), is specific to the time the invention was made.

25. Applicant argues on page 2 of the remarks - "*Moreover, in Dellert, it is the consumer who owns the image.... Dellert teaches providing a consumer with electronic*

access to images that the consumer owns. In contrast, image archives maintained by governmental agencies are not commercial repositories for images owned by consumers. The images are owned by the government."

c. Examiner's response - The claims do not include limitations regarding the ownership of the images or any particularly attributes of "image archives maintained by government agencies".

d. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

26. Applicant argues on page 3 of the remarks - "*Limitations in claim 5 have been improperly disregarded by the Office, as "descriptive." Applicant respectfully disagrees. The "descriptive" case law cited in the Action involves information printed on, or stored on, a physical medium. Gulack involved nonfunctional matter printed on a substrate. Lowry involved a data structure stored in a memory. (Moreover, Lowry's claim was found patentable by the CAFC: "The Board erred by denying patentable weight to Lowry's [claim] limitations."*)"

e. Examiner's response - The principles of the cited case law still apply when one analyzes the claim language. Particularly, claim 5 is dependent on claim 1. Claim 1 discloses both a "government agency" and a "image". An image is solicited from the government agency and received from the government agency.

f. Claim 5 states that the government agency is a "motor vehicle licensing agency". The steps of contacting, soliciting, receiving and printing as claimed in claim 1, are not altered or responsive to the government agency being a "motor vehicle licensing agency". The steps would be performed the same regardless of

the government agency being a "motor vehicle licensing agency". As such, the "motor vehicle licensing agency" language is only describing the type of agency and is therefore descriptive material and does not patentably distinguish the claimed invention.

g. Claim 5 states that the image is a "driver license photo". The steps of contacting, soliciting, receiving and printing as claimed in claim 1, are not altered or responsive to the image being a "driver license photo". The steps would be performed the same regardless of the image being a "driver license photo". As such, the "driver license photo" language is only describing the type of image and is therefore descriptive material and does not patentably distinguish the claimed invention.

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


Art Unit: 2155


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


David Lazaro
March 5, 2007


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER